

BRIEF FOR APPELLEE DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

2006-1308
(Serial No. 09/612,821)

IN RE PAUL C. ZIMMER

Appeal from the United States Patent and Trademark Office,
Board of Patent Appeals and Interferences.

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September 11, 2006

Representative Claim

1. A promotional calendar comprising:

a series of pages each imprinted with a respective day of the year and held together to allow turning or tear off of each page;

each page prominently printed with the name of a person to personalize each page of the calendar;

each page also prominently printed with an identifier of an enterprise to be promoted, whereby said person's name and said enterprise identifier are visually associated on each page.

A79.

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STATEMENT OF RELATED CASES

The Director is not aware of any other appeal from the Board of Patent Appeals and Interferences in connection with application Serial No. 09/612,821 that has previously been before this or any other court. There is no known related case pending in this or any other court.

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I. STATEMENT OF THE ISSUE

Zimmer claims a tear-away daily calendar with a person's name and the name of an enterprise on each page. His claims were found obvious. The sole issue on appeal is whether substantial evidence supports the Board's findings underlying the obviousness determination: (i) tear-away daily calendars with additional printed matter, including advertising, have been known in the art for almost 100 years (Hallam) and (ii) the difference (if any) in the content of the printed matter is insufficient to warrant a new patent.

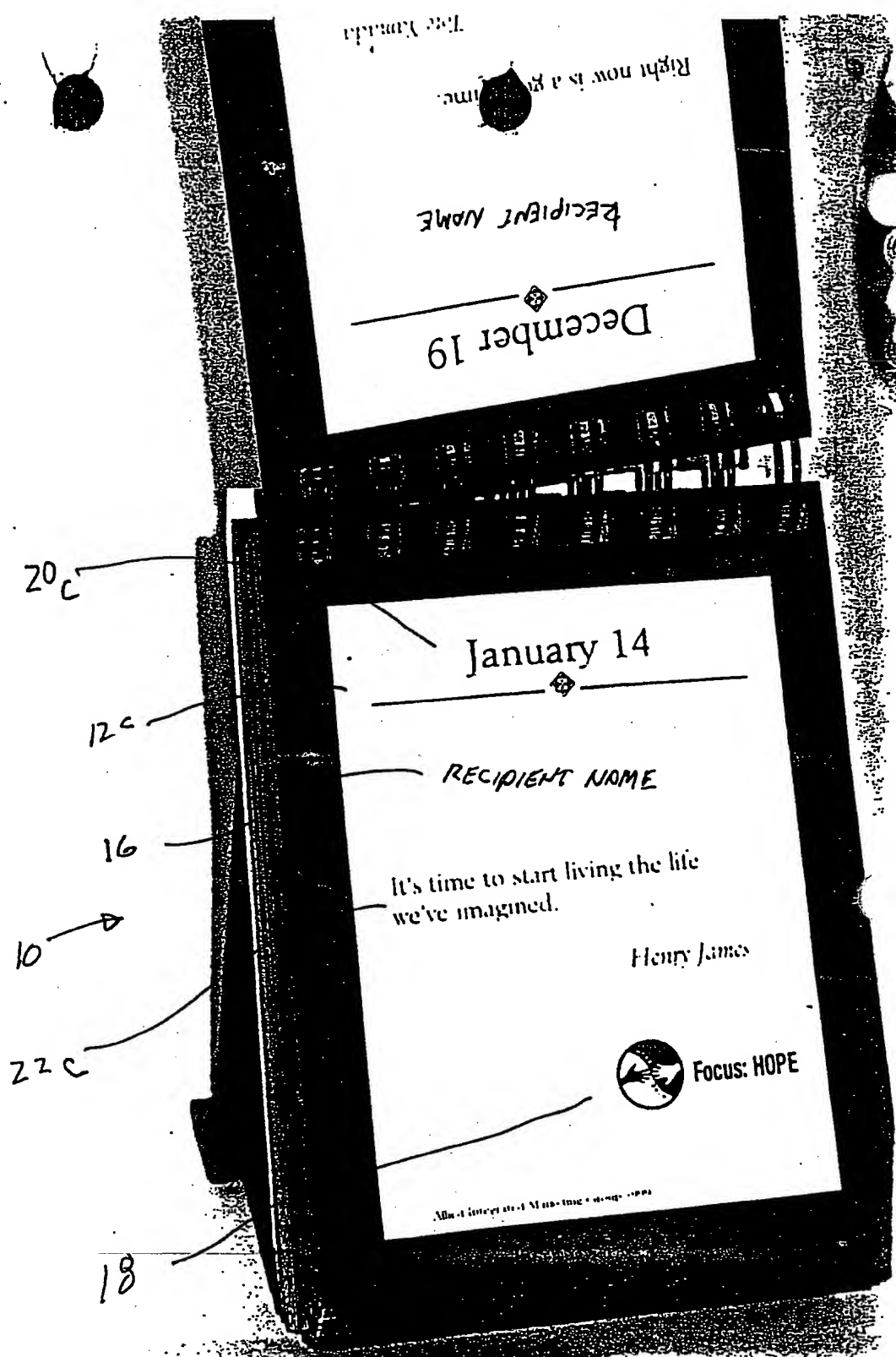


FIGURE 3

II. STATEMENT OF THE CASE

This appeal arose out of the examination of patent application Serial No. 09/612,821 ('821 application) filed by Paul C. Zimmer. A37-85.¹ The Examiner rejected all pending claims as obvious because applicant merely combined the prior art with nonfunctional descriptive matter. A62-65. The Board affirmed the rejection, A78-84, and re-affirmed it after Zimmer requested reconsideration. A1-4. Zimmer now appeals to this Court.

III. STATEMENT OF THE FACTS

A. Zimmer's Claimed Invention: A Tear-Away Daily Calendar with Names on Each Page

Zimmer claims a promotional calendar with a page for each day, where each page may be turned or torn off as the days go by. A71-72. Thus, he essentially claims a standard tear-off daily calendar known in the art. A80.

Zimmer attempts to distinguish his invention from the prior art by including on each page: (i) the name of a person, and (ii) the name of an enterprise (e.g., a company name). Figure 3 (shown on facing page) is an example of the claimed calendar.

¹ References to the Appendix are designated "A__." References to Zimmer's brief are designated "Br. at __."

G. M. HALLAM.
ADVERTISING DEVICE.
APPLICATION FILED SEPT. 18, 1906.

964,967.

Patented July 19, 1910.

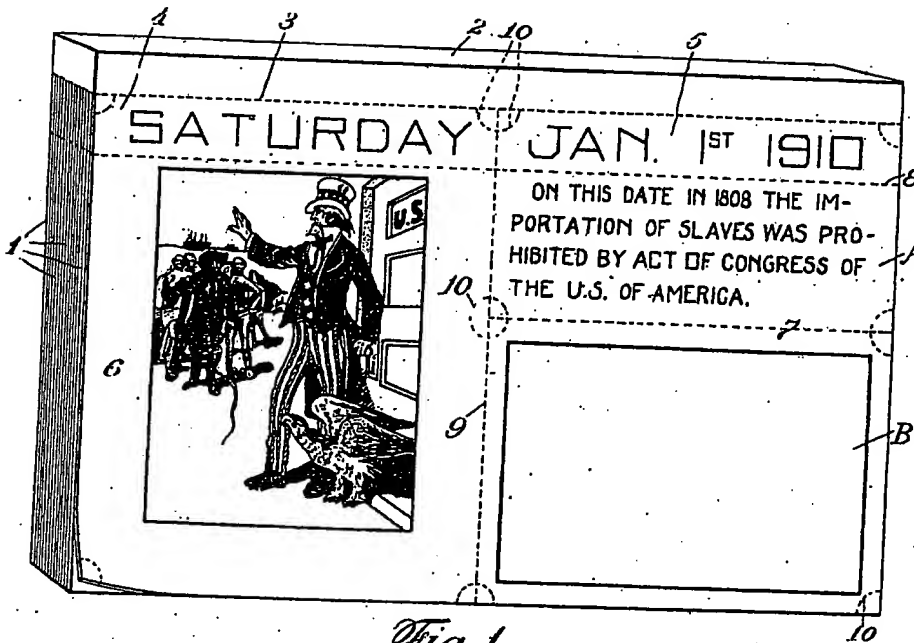


Fig. 1.

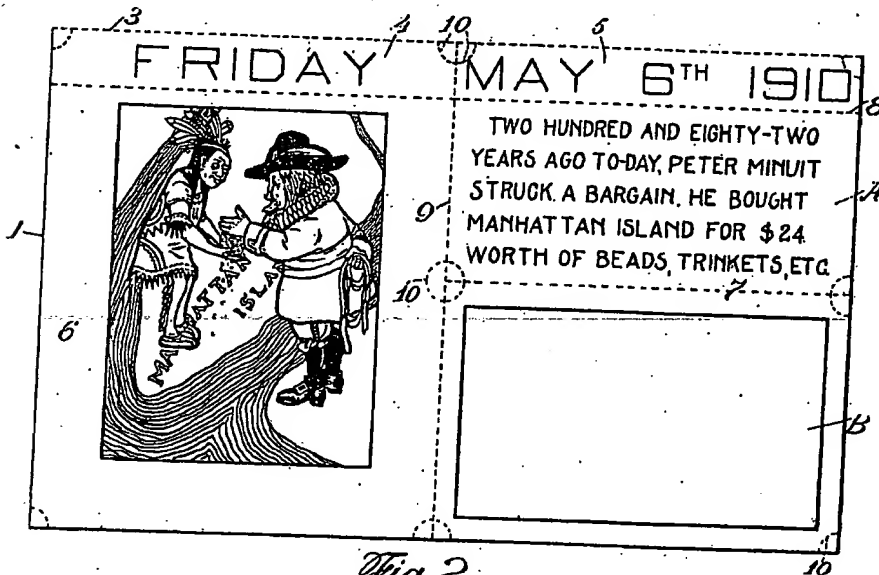


Fig. 2.

Witnesses:
Sara B. Bourke
Alan C. McDowell.

Inventor:
Guy M. Hallam
By his Attorney:
William R. Baird

Zimmer also claims a method of “promoting an enterprise” by printing a person’s name and the enterprise’s name on a daily calendar and then giving the calendar to the person. A71, claim 4.

B. The Prior Art: Hallam – a Tear-Away Daily Calendar with Various Printed Matter, Including Advertising Material

The use of a daily tear-off calendar has been known for close to 100 years. U.S. Patent No. 964,967, entitled “Advertising Device,” issued to Hallam in 1910. A90-92. Figure 1 of Hallam (reproduced on the facing page) shows a calendar consisting of daily tear-off sheets. A90, Fig. 1; A91, col. 1, ll. 15-25. Each page of Hallam’s calendar contains printed material, besides the day and date, and an illustration with information about that date in history. A90, Fig. 1.

Hallam’s calendar is an “attractive advertising device.” A91, col. 1, ll. 8-9. He designed his tear-away calendar as a “collection of advertising sheets.” A91, col. 1, ll. 18-19. Each sheet includes a space “reserved for advertising matter,” that allows the user to insert any material, including advertising copy, that the user desires. A90, Fig. 1, 7B; A91, col. 1, ll. 34-36.

C. The Board Decision

The Board’s decision affirmed the Examiner’s rejection of Zimmer’s

claims, using claim 1 as representative.² The Board agreed with the Examiner that the only difference between the claimed calendar and Hallam's 1910 calendar was the "content of the printed matter placed on each page." A82. Applying this Court's "printed matter doctrine," the Board then considered whether there existed any "new and nonobvious functional relationship between the printed matter and the substrate." A82, citing *In re Ngai*, 367 F.3d 1336, 1338 (Fed. Cir. 2004) and *In re Gulack*, 703 F.2d 1381, 1386 (Fed. Cir. 1983). It decided there was not.

The Board found no new and nonobvious functional relationship between the names printed on the calendar and the calendar itself. A82. Instead, the functional relationship between the names and Zimmer's calendar was the same as the relationship already present between the printed matter and the calendar in Hallam. A82. Therefore, the Board affirmed the Examiner's rejection. A83.

Zimmer requested reconsideration of the Board decision and asked that the Board consider method claims 4 and 5 separately from representative

² This was the Board's second decision in this case. An earlier decision, after considering Hallam, A90-92, in combination with Deaton, A93-98, remanded the case to the Examiner for consideration of the printed matter doctrine. A48.

claim 1. The Board granted the request and addressed the method claims separately, but did not change its decision to affirm the Examiner's rejection of all claims. A3. Specifically the Board again found that: (i) the only differences between Zimmer's invention and Hallam's calendar was the content of the printed matter, and (ii) Zimmer's printed matter did not have a new and nonobvious functional relationship with the calendar pages when compared to the functional relationship already disclosed in Hallam. A2.

IV. SUMMARY OF THE ARGUMENT

Zimmer claims a tear-away daily calendar with a separate detachable sheet for each day of the year. On each page of the calendar, Zimmer prints the name of an individual and the name of a company. Tear-away daily calendars with a variety of printed matter, including advertising, have been known for close to 100 years. For example, Hallam discloses a tear-away daily calendar with the day, date, and additional printed matter on each page.

The only difference between Zimmer's claimed calendar and Hallam, if any, is the specific content of the printed matter that appears on the pages, *i.e.* names versus historical information and advertising. However, since the Board properly found that there was no new and nonobvious functional

relationship between Zimmer's printed matter and the underlying calendar, Zimmer is not entitled to a new patent on a known calendar with his specific printed matter. Zimmer's method claims fail for the same reason.

V. ARGUMENT

A. Standard of Review

Zimmer's claims stand rejected as obvious under 35 U.S.C. § 103. Obviousness is a question of law supported by underlying facts. *In re Gartside*, 203 F.3d 1305, 1315-16 (Fed. Cir. 2000). Whether printed matter recited in a claim has a functional relationship with the substrate is a question of fact. *See Gulack* at 1386 (finding that measurements were functionally related to the substrate). *Cf. Hupp v. Siroflex of Am., Inc.*, 122 F.3d 1456, 1460 (Fed. Cir. 1997) (whether a patented design is functional or ornamental is a question of fact). On appeal, the Board's legal conclusion of obviousness is reviewed without deference, while its factual findings are reviewed for substantial evidence. *Gartside*, 203 F.3d at 1315.

Substantial evidence is "such relevant evidence as a reasonable mind might accept as accurate to support a conclusion." *Consolidated Edison Co. v. NLRB*, 305 U.S. 197, 229 (1938). As this Court recently stated, "where two different, inconsistent conclusions may reasonably be drawn from the

evidence in record, an agency's decision to favor one conclusion over the other is the epitome of a decision that must be sustained upon review for substantial evidence." *In re Jolley*, 308 F.3d 1317, 1329 (Fed. Cir. 2002).

B. Zimmer's Claimed Tear-Away Daily Calendar Is Unpatentable

1. Tear-away daily calendars are not new

Zimmer claims a promotional calendar that has a single page for each day of the year. Zimmer's claimed pages may be torn off as each day goes by. A79.

Hallam discloses a daily calendar in 1910. A90-92. Hallam discloses a collection of sheets, which are bound together. A91, col. 1, ll. 18-22. Each of Hallam's sheets are imprinted with one day and date, and are designed to be torn off daily. A91, col. 1, ll. 21-31; A90, Fig. 1, 5.

2. Tear-away daily calendars with additional printed matter, including advertising, are not new

Zimmer claims also recite additional elements consisting of printed matter, which allow the calendar to be used for "promotion and advertising." A6 (emphasis added). These elements consist of the name of a person and an "enterprise identifier," which may be the name and logo of a company or other enterprise. A8, ll. 8-13. Hallam also discloses additional printed

matter, which allows Hallam's calendar to be used as an "advertising device."

A91, col. 1, ll. 5-8; A91, title (emphasis added). Hallam's printed matter consists of illustrations, historical information, and "advertising material."

A91, col. 1, ll. 30-36.

3. Any differences in the printed matter claimed by Zimmer does not warrant a patent because the printed matter does not have a new and nonobvious functional relationship with the underlying calendar

The Board and the Examiner both found that the only difference between Zimmer's claimed promotional calendar and Hallam's promotional calendar is the printed matter, i.e., Zimmer's names versus Hallam's pictures, historical data, and advertising.

Zimmer's printed matter, however, does not have a new and nonobvious functional relationship with the underlying calendar. A82. Simply put, Zimmer's printed matter does not change the calendar's primary function – the calendar still tracks the days like Hallam's calendar. And Hallam, like Zimmer, adds additional printed matter for advertising and promotional reasons. A91, col. 1, ll. 5-8; title.

Zimmer claims that the "new and unobvious function" is presenting the person's name in close proximity to the enterprise identifier, which "create's

a mental association” between the person and the enterprise. Br. at 10. The Board found, however, that even if Zimmer’s printed matter created such a mental association it still did not confer patentability because there was no “new and unobvious functional relationship between the printed matter and the substrate.” A82(emphasis added).

The Board properly realized that the relationship between Zimmer’s printed matter and his calendar is the same as the relationship between Hallam’s printed matter and his calendar. A82. Both use the calendar as a mere substrate for displaying additional information, including advertising. The calendar is still a calendar. The words, if presented without the calendar, would still have the same meaning to the reader. Even if Zimmer promotes differently than Hallam advertises, both calendars serve a similar additional function – advertising and promotion.

Zimmer’s reliance on *Application of Miller*, 418 F.2d 1392 (CCPA 1969) is misplaced. *Miller* examined the functional relationship between a cup and the matter printed on the cup. The printed matter, lines and numbers on the side of the cup, indicated the fill level for one-half the actual volume. There, the Court found that these indicia did have a new and nonobvious

functional relationship, *id.* at 1396, because the printed matter converted the cup into a “half-recipe” measuring device, which saved cooks the calculation necessary to reduce an entire recipe to a smaller portion – a new and nonobvious function. Miller’s cup might be analogous if Zimmer had applied for the first patent converting an ordinary pad of paper into a tear-off daily calendar. But that is not the case here. Zimmer fails to achieve any new function. The prior art promotional calendar remains a promotional calendar despite Zimmer’s addition of different promotional information.

Zimmer also argues that users see the printed matter daily, which will create a mental association between them and the enterprise being promoted. Br. at 10. This is not a new and nonobvious functional relationship between the printed matter and the underlying calendar. Every daily tear-off calendar is meant to be looked at daily. All the printed matter on the daily calendar is meant to be seen every day. And when used for promotional purposes, as in Hallam, the promotional material or advertising copy printed on the page will be read and understood by the user. That Zimmer prints the same advertising on each page does not mean he has changed the relationship between the printed matter (advertising) and the calendar. Compare *Gulack* where the

printed matter, an “endless sequence” of digits, did interact in a new way with the “endless” band by “exploit[ing] the endless nature of the band.” *Id.* at 1386-87. Here, the daily nature of the calendar is being exploited, if at all, in the same way as in Hallam – by providing advertising every day.

Borrowing from *Ngai*, if the Court were to adopt Zimmer’s position, then anyone could continue patenting prior art promotional calendars simply by adding different advertising copy to each page of the calendar. *Ngai* at 1339 (“If we were to adopt Ngai’s position anyone could continue patenting a product indefinitely provided they add a new instruction sheet to the product.”)

C. Zimmer’s Method Claims Are Likewise Unpatentable

Zimmer argues that method claims 4 and 5 are not subject to the printed matter doctrine because the case law has only applied that doctrine to articles of manufacture. Br. at 16-17. That is incorrect. This Court’s predecessor was confronted with the same argument over 50 years ago and found that the principles of the printed matter doctrine are equally applicable to method and article claims. *In re Rice*, 132 F.2d 140, 141 (CCPA 1942). *See also In re McKee*, 64 F.2d 379, 380 (CCPA 1933) (method of marking meat with brand

name of manufacturer unpatentable in light of stamping machine marking meat with other letters or words).

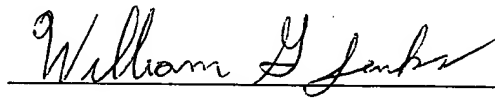
Furthermore, Zimmer's method claims recite only the steps for promoting an enterprise by assembling the promotional calendar of claim one – printing the recipient's name on the calendar, etc. – and then giving the calendar to an individual. Br. at 5. This is not a new use for an old product, as were the allowable method claims in *Ngai*. *Id.* at 1338. Rather, Zimmer simply claims giving the calendar, recited in his apparatus claims, to an end user. This was disclosed in Hallam. A91, col. 1, ll. 34-36.

The Board correctly found that the only difference between these method claims and the prior art again lay solely in the content of the printed matter. A2-3. And therefore the critical question again is whether there exists any new and nonobvious functional relationship between the printed matter and the substrate. *Ngai*, 367 F.3d at 1338 (citing *Gulack*, 703 F.2d at 1386). The Board, again, correctly found that there was no such new and nonobvious functional relationship between Zimmer's printed names and the calendar the names were printed on. A2-3; A81-82.

VI. CONCLUSION

Because substantial evidence supports the Board's rejection of Zimmer's claims to a tear-away daily promotional calendar with names on it, this Court should affirm that decision.

Respectfully Submitted,

A handwritten signature in dark ink, appearing to read "William G. Jenks", is written over a horizontal line.

September 11, 2006

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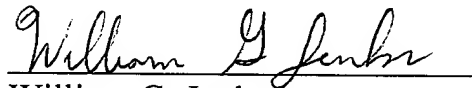
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CERTIFICATE OF SERVICE

I hereby certify that on September 11, 2006, I caused two copies of the foregoing BRIEF FOR APPELLEE DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE to be transmitted via overnight express, addressed as follows:

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